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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	P66458US0	4101

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WASHINGTON, DC 20004

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

10

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/801,187

Applicant(s)
Yokokawa

Examiner
Nasser Ahmad

Art Unit
1772



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 25, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-77 is/are pending in the application.
- 4a) Of the above, claim(s) 45-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Newly submitted claims 45-77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 11-44 are directed to a sheet structure and classified in class 428, subclass 40.1 (group I). While, claims 45-77 are directed to a method of forming separable sheet portions and classified in class 156, subclass 250 (group II). The inventions are distinct from each other because: Inventions I and II are related as product made and process of making the product. In the instant case the product can be made by a materially different process such as, without bending upwardly or downwardly, the portions are pulled apart along the cut lines.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-17, 19-31 and 35-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Cancio (4,380,564 or 4,465,729).

Cancio relates to a decorative sheet material having intersecting tear lines formed in a surface thereof (abstract). The tear lines are grooves (16) and (18) as shown in figure-2 along

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which the sheet is divided. The sheet material can be a resin film or its laminate with paper (col. 4, lines 64-65 of Cancio '564 and col. 4, lines 57-59 of Cancio '729). The film is provided to receive prints or decorative design on its surface. Further, because Cancio teaches that "sheet may be provided with adhesive" (Cancio '564; col. 2, lines 33-34 and Cancio '729; col.2, lines 40-41), said phrase infers to the possibility of the sheet material being without adhesive.

When adhesive is present, both the resin film and the adhesive layer are provided with grooves. The adhesive can have protective release liner thereon.

The cutlines or grooves form an entire perimeter of at least one of the sheet portions.

The intended use phrases such as "allowing the sheet to be bent...", "are printable", etc. have not been given patentable weight as said phrase are not found to be positive limitation.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cancio in view of Kishimoto (5,560,966).

Cancio '564 and '729, as discussed above, fails to teach expressly that the resin film is overlaid with an image receiving layer coat. Kishimoto relates to a resin film with tear line (abstract). The film is provided thereon with a light sensitive layer, or printed, or processed image layer (col. 3, lines 10-12). The presence of printed or processed image layer indicates the presence of image receiving layer coat and that said image and print are functionally equivalent to provide decorative effect thereto. Therefore, it would have been obvious to one having

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ordinary skill in the art to utilize Kishimoto's teaching that printed indicia and processed image are functionally equivalent and that processed image can be substituted for the print in the invention of Cancio.

8. In response to applicants' arguments filed on November 25, 2002, applicant has failed to show that Cancio patents would not be bendable. Also, please note that the "bendability" phase in the instant claims is directed to an intended use and hence, not deemed to be positive limitation. As for the Kishimoto patent, it was cited to show that use of processed image being obvious.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

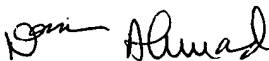
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 703-308-4424. The examiner can normally be reached on Monday-Thursday from 7:30 am to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Ahmad/T.G.D.
February 21, 2003


NASSER AHMAD
PRIMARY EXAMINER